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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,085	11/02/1999	TAKAYUKI MITSUYA	1422-401P	6326

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EXAMINER

MADSEN, ROBERT A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 02/13/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,085

Applicant(s)

MITSUYA ET AL.

Examiner

Robert Madsen

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 20 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37.CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment and Declaration Under 37 CFR 1.132 filed November 20, 2002 have been entered. Claims 13-23 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuya et al. (JP409009878A) in view of Levin (US 3881034), Yano et al. (US 4234619), Ueda et al. (US 5487911), and Hamaguchi (US 5127953).
4. See the reasons of record in Paper No. 11.
5. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuya et al. (JP409009878A) in view of Ueda et al. (US 5487911), Yano et al. (US 4234619), Hamaguchi (US 5127953), Likuski et al. (US 4971820), Broderick et al. (US 5139787), Maloney et al. (US 3505076), and Meusel (US 2786766).
6. See the reasons of record in Paper No. 19.
7. Claims 13, 15-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi (US 5127953) in view of Mitsuya et al. (JP409009878A), Yano et al. (US 4234619), and Levin (US 3881034).
8. See the reasons of record in Paper No. 19.

Art Unit: 1761

9. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi (US 5127953) in view of Mitsuya et al. (JP409009878A) Yano et al. (US 4234619), and Levin (US 3881034), as applied to claims 13,15-17, and 19, further in view of Ueda et al. (US 5487911).

10. See the reasons of record in Paper No. 19.

Response to Amendment

11. The Declaration under 37 CFR 1.132 filed November 20, 2002 is insufficient to overcome the rejection of claims as set forth in the last Office action because: The comparisons presented in the declaration are between the recited invention and *an individual reference*, Hamaguchi (US 5127953), applied in the previous office action. However, the rejections were not based on Hamaguchi alone. Although applicant has shown one does not obtain the invention with the teaching Hamaguchi, applicant *has not* shown that one does not obtain the invention by either modifying Hamaguchi with the other references or modifying other references with Hamaguchi. Applicant has not shown that the rejections include any unobvious combinations or why one would not be motivated to combine the various references. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

12. Applicant's arguments filed November 20,2002 have been fully considered but they are not persuasive.

Art Unit: 1761

13. With respect to the arguments presented for claims 13, 15-17, 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi (US 5127953) in view of Mitsuya et al. (JP409009878A), Yano et al. (US 4234619), and Levin (US 3881034), applicant argues that the declaration of November 20, 2002 shows that Hamaguchi does not obtain applicant's invention. It is noted that Hamaguchi meets all of the limitation of claim 13, except the origin of the egg protein (i.e. from the egg white versus the recited egg yolk). The additional references are relied as evidence of using other egg derived proteins for the same art recognized purpose, but applicant has not shown why one of ordinary skill in the art would not make the substitution of one type of egg protein for another. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

14. With respect to applicant's arguments presented to claims 13-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuya et al. (JP409009878A) in view of Levin (US 3881034), Yano et al. (US 4234619), Ueda et al. (US 5487911), and Hamaguchi (US 5127953) and claims 20-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuya et al. (JP409009878A) in view of Ueda et al. (US 5487911), Yano et al. (US 4234619), Hamaguchi (US 5127953), Likuski et al. (US 4971820), Broderick et al. (US 5139787), Maloney et al. (US 3505076), and Meusel (US 2786766), as discussed previously declaration of December 4, 2001 shows that Mitsuya does not obtain applicant's invention. However, the rejections are based on a combination of

Art Unit: 1761

references, not Mitsuya alone. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. With respect to the amended claim 13, the inclusion of "spray-dried, porous" in claim 13 and 18, does not overcome the rejections of record. Both Hamaguchi and Mitsuya teach the "porous" feature, by the simple fact that both teach mixing oil with a egg protein particles without the sphere *exuding* oil. The exuding the oil would not even have been an issue if the egg protein particles were not porous to absorb the oil in the first place. The "spray-dried" limitation is a process limitation, making claim 13 a product-by-process claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)). With respect to Hamaguchi, it is noted that Hamaguchi teaches the physical product limitations of an egg protein impregnated with oil, and therefore meets the product limitation. With respect to Mitsuya, Mitsuya teaches spray dried delipidated egg yolks.

16. With respect to claims 14 and 18, applicant argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed

Art Unit: 1761

invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

17. Regarding applicant's request of evidence of pore size being affected by temperature/pressure : See Weers et al. (US 6309623 B1) teaches *spray drying conditions* egg proteins to form spherical porous particles (Column 18, lines 10-20) and teach the pore size of a spray dried material is determined by variables such as temperature and pressure, such as spray drying under vacuum (Column 14, lines 15-19, Column 21 line 23 to Column 23, line 24). Additionally, See Perry's Chemical Engineer's Handbook, Page 12-85, which explains that bulk density, which is a direct result of porosity, is affected by temperature (Column 2, Paragraphs 4 and 5).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weers et al. (US 6309623 B1) teaches spray dried egg protein pore size may be affected by pressure and other spray-drying conditions. Perry et al. (1997) teaches spray-drying conditions affecting porosity (i.e. bulk density).

Art Unit: 1761

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (703)305-0068. The examiner can normally be reached on 7:00AM-3:30PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703)308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-0061.

Robert Madsen
Examiner
Art Unit 1761
February 9, 2003




STEVE WEINSTEIN
PRIMARY EXAMINER

1761

For M. Cano